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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,180	02/25/2002	Bruce L. Davis	P0585	1232
23735	7590	01/27/2006		
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			EXAMINER LAZARO, DAVID R	
			ART UNIT 2155	PAPER NUMBER
DATE MAILED: 01/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/086,180	<b>Applicant(s)</b> DAVIS, BRUCE L.	
	<b>Examiner</b> David Lazaro	<b>Art Unit</b> 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11/03/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 16-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In view of the Appeal Brief filed on 11/03/2005, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-15, drawn to methods of distributing a trusted image, classified in class 709, subclass 217.
  - II. Claims 16-20, drawn to a document printing method, classified in class 358, subclass 3.28.
  - III. Claims 21-26, drawn to a method of providing an access credential for a person, classified in class 713, subclass 176.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as allowing individuals to electronically request an image of themselves from a government agency and the government agency electronically transmitting the image to the individual. See MPEP § 806.05(d).
4. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as steganographically encoding a graphic such that it can be used as an access credential to gain access to a restricted area.. See MPEP § 806.05(d).
5. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as using steganographically encoded data on a digital photo to generate text to be printed with the digital photo. See MPEP § 806.05(d).
6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with William Conwell (31,943) on January 17, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

8. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

9. Particularly, Claims 1 and 11 contain subject matter related to a user electronically contacting a governmental agency and soliciting an image depicting the user stored in an archive maintained by said governmental agency. In the appeal brief filed 11/03/05, the applicants state on page 13,

*"Although government agencies have maintained image archives for years... Appellants' specification is believed to be the first to teach or suggest that an individual may obtain their own archived photo from a government agency, e.g., for printing at home."*

10. The clearest example of this subject matter and supposed teaching in the specification is described on page 13. Page 13 of the specification states, "Upon

*receipt of the access code, the candidate downloads from the web site of the state Department of Motor Vehicles the latest copy of her driver's license photo."* Based on such a description, it is not clear as to how one skilled in the art could make or use the invention. There is no information describing how a government agency's image archive could be incorporated into a system such that an individual user's image could be solicited and accessed from the web site. There is no information describing the actual electronic solicitation of the image in terms of what information is transferred as part of the solicitation and how the information would be processed by the government agency. Furthermore, the examiner feels the applicants recognize the security concerns of access to such an image database as applicants comment page 13 of the appeal brief, *"Indeed, it is evident that self-printing of identification cards would be non-obvious to an artisan, due to the obvious security shortcoming associated with such a practice."* Yet the specification has no description of any security or authorization of the individual user requesting their image. This also leads to the question of the cooperation of the government agency. How can one skilled in the art make and use the invention unless it can be guaranteed that a given government agency will permit an individual to electronically request and access his or her own archived photo. The specification does not describe any example government agency that, at the time of filing, would permit such a system. The examiner considers this to be further evidence that the claimed subject matter is not described in such a way as to enable one skilled in the art to make and use the invention.

11. For these reasons, claims 1-15 fail to comply with the enablement requirement.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 2, 3, 5, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by applicants Information Disclosure Statement (submitted 01/05/2005) related to operations of the State of California and Citibank in 1995 (hereinafter Citibank).

14. With respect to Claims 1 and 10, Citibank teaches a method of printing a trusted image, comprising:

an individual user electronically contacting a government agency, soliciting an image depicting the user stored in an archive maintained by said government agency (The examiner considers the individual user authorizing Citibank to obtain their photograph and Citibank subsequently electronically soliciting the user's image from NBS, to be within the scope of the claim language. The individual initiates the request with Citibank electronically contacting NBS on behalf the individual. As NBS is under contract with the State of California, it can be considered part of a government agency.)

electronically receiving said image from said contacted government agency (NBS electronically sends the photo images back to Citibank); and

printing a document incorporating said image (credit card is printed bearing individual's photograph).

15. With respect to Claim 2, Citibank teaches all the limitations of Claim 1, in which it is the individual user who receives said image and prints said document (Citibank receives the image and prints the document. The examiner considers Citibank to be the equivalent of the individual user as it is acting directly on behalf of the individual user).

16. With respect to Claim 3, Citibank teaches all the limitations of Claim 1, in which said document is a photo identification document (The credit card with an individual's photograph can be considered a photo identification document.).

17. With respect to Claim 5, Citibank teaches all the limitations of Claim 1, in which the governmental agency is a motor vehicle licensing agency, and the image is a driver license photo (The photo on the credit card is a driver license photo from the driver license image archives for the State of California at that time).

18. With respect to Claim 11, Citibank teaches a method of distributing a trusted image, comprising:

at a government agency, receiving an electronic request for an archived personal image from an individual depicted in said image (NBS electronically receives a request for an archived personal image for particular individuals. The request is made by Citibank on behalf of the particular individuals who have authorized Citibank to request their photo. The examiner considers this to be within the scope of the claim language. The individual initiates the request with Citibank electronically contacting NBS on behalf the individual. As NBS is under contract with the State of California, it can be considered part of a government agency.); and



electronically transmitting said image to said individual (NBS electronically sends the image to Citibank. Citibank is acting on behalf of the individual and can therefore be considered the equivalent).

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 4, 6-9 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Citibank in view of U.S. 5,841,886 by Rhoads (Rhoads).

21. With respect to Claim 4, Citibank teaches all the limitations of Claim 1, but does not explicitly disclose said document is an identification badge.

Rhoads teaches identification documents can include both credit cards and identification badges (Col. 1 lines 27-34 and Col. 6 lines 44-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Citibank and modify it as indicated by Rhoads such that said document is an identification badge. One would be motivated to have this as both photo badges and cards are related to the problem of identifying the person bearing them (In Rhoads: Col. 1 lines 27-34 and Col. 6 lines 44-57).

22. With respect to Claim 6, Citibank teaches all the limitations of Claim 1, but does not explicitly disclose said image is processed with an identification code by the governmental agency.

Rhoads teaches an image can be processed with an identification code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Citibank and modify it as indicated by Rhoads such that said image is processed with an identification code. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

23. With respect to Claim 7, Citibank teaches all the limitations of Claim 1, but does not explicitly disclose said image is digitally watermarked with a plural-bit code by the governmental agency.

Rhoads teaches an image can be digitally watermarked with a plural-bit code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Citibank and modify it as indicated by Rhoads such that said image is digitally watermarked with a plural-bit code by the governmental agency. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

24. With respect to Claim 8, Citibank in view of Rhoads teaches all the limitations of Claim 7, in which said plural bit code serves to identify the individual user's name (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

25. With respect to Claim 9, Citibank in view of Rhoads teaches all the limitations of Claim 8, in which said plural-bit code comprises an index into a data structure in which the individual user's name is stored (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

26. With respect to Claim 12, Citibank teaches all the limitations of Claim 11, but does not explicitly disclose processing said image with an identification code prior to said electronic transmission.

Rhoads teaches an image can be processed with an identification code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Citibank and modify it as indicated by Rhoads such that said image is processed with an identification code prior to electronic transmission. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

27. With respect to Claim 7, Citibank teaches all the limitations of Claim 11, but does not explicitly disclose digitally watermarking said image with a plural-bit code prior to said electronic transmission.

Rhoads teaches an image can be digitally watermarked with a plural-bit code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Citibank and modify it as indicated by Rhoads such that said image is digitally watermarked with a plural-bit code prior to electronic transmission. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

28. With respect to Claim 8, Citibank in view of Rhoads teaches all the limitations of Claim 13, in which said plural bit code serves to identify the individual user's name (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

29. With respect to Claim 9, Citibank in view of Rhoads teaches all the limitations of Claim 14, in which said plural-bit code comprises an index into a data structure in which the individual user's name is stored (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

### ***Conclusion***

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


31. U.S. Patent 5,760,916 by Dellert et al. "Image handling system and method" June 2, 1998. Discloses general aspects of communicating and printing digital images.

32. U.S. Patent 6,058,428 by Wang et al. "Method and apparatus for transferring digital images on a network" May 2, 2000. Discloses transferring digital images on a network and printing of such images.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David Lazaro  
January 20, 2006

  
SALEH NAJJAR  
SUPERVISORY PATENT EXAMINER